

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TINA BUTLER

Appeal No. 2003-1439
Application No. 09/896,112

ON BRIEF

Before TIMM, DELMENDO, and MOORE, *Administrative Patent Judges*.
MOORE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 and 3-18. Claim 2 has been canceled. Thus, only claims 1 and 3-18 are before us on this appeal.

REPRESENTATIVE CLAIM

1. An ice pack for a horse, comprising:

a main panel sized to fit over a horse's back and sides, the main panel including side sections extending from opposite sides of a center section;

a strap secured to the main panel that secures the main panel to a horse; and

a plurality of ice pockets attached to each of the side sections of the main panel.

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The References

In rejecting the claims under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a), the examiner relies upon the following references:

Thomas et al. (Thomas)	5,215,080	Jun. 01, 1993
Brink et al. (Brink)	5,697,962	Dec. 16, 1997
Thielemann	6,138,611	Oct. 31, 2000

In formulating the new grounds of rejection, we rely upon the following references:

De Rosa	4,033,354	Jul. 05, 1977
Buckley	6,086,609	Jul. 11, 2000
Puiello	3,999,521	Dec. 28, 1976

The Rejections

I. Claims 1, 7, 12-14, and 16-18 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Thomas.

II. Claims 3-6, 8-11, and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Thomas in view of Brink, further in view of Thielemann.

The Invention

The invention relates to an ice pack for a horse, which ice pack is formed from a main panel which fits over the horse's back and sides. Ice pockets are formed in the panel. (Appeal Brief, page 2, lines 8-14).

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I. The Rejection of Claims 1, 7, 12-14, and 16-18 under
35 U.S.C. § 102(e) as being unpatentable over Thomas

The examiner has found that Thomas discloses an ice pack 10 with a main panel 34 with side sections 33 and 35, straps for securing the ice pack, a plurality of ice pockets 24, and an ice pack formed of fabric material. (Final Rejection, page 2, paragraph number 3).

The appellant asserts that she has invented an ice pack which is particularly configured for a horse. (Appeal Brief, page 3, lines 23-24).

The examiner replies that the recitation "for a horse" recites only the manner in which the apparatus is to be employed and does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. (Examiner's Answer, page 3, lines 8-11).

While this general statement of law is true, we read the claim differently than the examiner. The claimed apparatus must be "sized to fit over a horse's back and sides," have "a strap secured to the main panel that secures the main panel to a horse," and have "a plurality of ice pockets attached to each of the side sections of the main panel" (claim 1). These are not statements of intended use, rather, they are structural limitations. We cannot find these limitations in the cited prior art.

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The examiner also states that it would have been obvious to one of ordinary skill in the art to configure the invention of Thomas to accommodate any animal suffering a muscle spasm, cramp, bruise, tear, sprain, or strain, including a horse. (Examiner's Answer, page 3, lines 14-17). We agree with this statement. However, obviousness and anticipation are different beasts.

The examiner did not alternatively reject these claims under 35 U.S.C. §103(a); consequently the question as to whether or not the modification to fit a horse would have been obvious is not germane to the anticipation question. The limitations "sized to fit over a horse", "a strap secured to the main panel that secures the main panel to a horse" and "a plurality of ice pockets attached to each of the side sections of the main panel" do differentiate over Thomas - we see no embodiment which is capable of being placed over a horse, held in place with a strap, and which also shows a plurality of ice pockets attached to each of the side sections of the main panel.

The examiner also urges that the preamble is not given patentable weight because the claim is drawn to a structure and the portion of the structure following the preamble is a self-contained description of the structure. While we agree with this interpretation of the claim, we again note that the body of the claim contains the limitations of being sized to fit the back and

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sides of a horse, and held in place on a horse with a strap, and having a plurality of ice pockets on each side. Consequently the fact that the preamble is nonlimiting misses the point.

In order for a reference to be anticipatory, it must disclose, either explicitly or implicitly, every element of the claim. See, In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). As the Thomas reference does not disclose sizing the apparatus to fit a horse's back and sides, the strap to secure the main panel to a horse, nor a plurality of pockets on each of the side panels, we are constrained to reverse this rejection.

II. The Rejection of Claims 3-6, 8-11, and 15 under 35 U.S.C. §103(a) as being unpatentable over Thomas in view of Brink, further in view of Thielemann

The examiner has found that Thomas discloses the invention substantially as claimed, including hook and loop fasteners. The examiner has found that positioning the ice pockets to rest adjacent to particular muscles would have been obvious since rearranging parts of an invention requires only routine skill in the art (Final Rejection, page 3, lines 8-15).

The appellant contends that Thomas only discloses an apparatus which can be moved from body part to body part, and, as a consequence, one of ordinary skill in the art would not be led to simply rearrange parts of these devices to rest adjacent

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particular muscles or even further to rest adjacent particular muscles of a horse. (Appeal Brief, page 5, lines 14-21).

Again, we are constrained to agree with the appellant. Nothing in Thomas discloses use for a horse or the plurality of ice pockets and the examiner has provided no reasoning which would support a prima facie case of obviousness. We therefore reverse this rejection.

New Ground of Rejection

We enter the following new grounds of rejection.

III. The Rejection of Claims 1, 3-4, 6-7, 9, and 12-18 Under 35 U.S.C. § 103 (a) over Buckley in view of De Rosa

Claims 1, 3-4, 6-7, 9, and 12-18 are rejected under 35 U.S.C. §103 (a) as unpatentable over Buckley in view of De Rosa.

We find that Buckley teaches a controlled cold therapy apparatus specifically for a horse (see Figure 1).

As for claim 1, Buckley discloses a main panel 19 sized to fit over a horse's back and sides, having side sections extending down the horse's sides from opposite sides of the center section; a strap 29 which secures the main panel to the horse, and a plurality of cooling conduits for cooling selected portions of the horse. (Figure 6, reference numeral 30).

De Rosa teaches a cooling garment to alleviate physiological strain due to heat stress (abstract). A plurality of water-filled

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pockets are frozen and secured inside the garment (column 2, lines 6-14) to cool the wearer. De Rosa teaches that ice can be used in place of cold water-cooling garments (column 1, lines 29-31) to avoid a rupture which renders the whole garment unusable.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the plurality of ice bags of De Rosa for the cooling apparatus of Buckley to avoid failures and high cost.

As for claim 3, Buckley and De Rosa are as above for claim 1.

We further find that Figure 6 of Buckley further illustrates the flow channels for treating a horse's back. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute an ice pocket of De Rosa in the center section of Buckley for the reduction in cost, bulkiness, and a reduction in likelihood of failure as noted in De Rosa.

We also find that Buckley teaches configuring the appliance to treat selected regions of the horse, including the withers, the loin, the back, and the croup. (Column 4, lines 15-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to position the ice pockets to rest adjacent particular muscles.

As for claim 4, we again find that Buckley teaches configuring the appliance to treat selected regions of the horse,

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including the withers, the loin, the back, and the croup. (Column 4, lines 15-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to position the ice pockets to rest adjacent the rhomboids, latissimus dorsi, longissimus dorsi, intercostal, serratus and thoracis muscles.

As for claim 6, both Buckley (column 5, lines 25-38) and De Rosa (column 2, lines 50-61) teach the use of a hook and loop fastener. It would have been obvious to one of ordinary skill in the art to choose the hook and loop fastener for ease of attachment of the device.

As for claim 7, De Rosa teaches making the garment out of fabric (column 2, line 21). It would have been obvious to one of ordinary skill in the art to choose a fabric to replace the unnecessarily complex rubber tubing enclosing garment of Buckley with the fabric of De Rosa to enable the user to utilize the ice packs of De Rosa in a less bulky garment (column 1, lines 33-34).

As for claim 9, De Rosa teaches that it is known to sew ice bags into a garment (Column 1, lines 49-50). Accordingly, it would have been an obvious to one of ordinary skill in the art at the time the invention was made, to sew the ice pockets into the main panel.

As for claim 12, Buckley discloses a main panel 19 sized to fit over a horse's back and sides, having side sections extending

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down the horse's sides from opposite sides of the center section; a strap 29 which secures the main panel to the horse, and a plurality of cooling conduits for cooling selected portions of the horse. (Figure 6, reference numeral 30).

De Rosa teaches a cooling garment to alleviate physiological strain due to heat stress (abstract). A plurality of water-filled pockets are frozen and secured inside the garment (column 2, lines 6-14) to cool the wearer. De Rosa teaches that ice can be used in place of cold water cooling garments (column 1, lines 29-31 to avoid a rupture which renders the whole garment unusable.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the plurality of ice bags of De Rosa for the cooling apparatus of Buckley to avoid failures and high cost.

As for claim 13, Buckley discloses a main panel 19 sized to fit over a horse's back and sides, having side sections extending down the horse's sides from opposite sides of the center section; and a plurality of cooling conduits for cooling selected portions of the horse including the back and sides. (Figure 6, reference numeral 30).

As for claim 14, De Rosa teaches a cooling garment to alleviate physiological strain due to heat stress (abstract). A plurality of water-filled pockets are frozen and secured inside

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the garment (column 2, lines 6-14) to cool the wearer in heated environments.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to secure the ice pockets to the center and side panels of the apparatus to provide cooling in those areas.

As for claim 15, De Rosa teaches that ice pockets may be sewn into the garment (column 1, lines 49-50). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to sew the ice pockets to the main panel.

As for claims 16, 17, and 18, Buckley discloses Velcro® straps (claim 18) which are secured to each side section (column 5, lines 25-38) (claim 16). De Rosa teaches that the straps may also be Velcro® and be two piece securable to each other (claim 17) and removable by pulling apart (column 2, lines 50-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the two-part velcro strips for the straps of Buckley in order to ease attachment of the device in the manner illustrated by DeRosa. It would also have been obvious to one of ordinary skill in the art to choose the hook and loop fastener for ease of attachment of the device.

IV. The Rejection of Claim 5 Under 35 U.S.C. § 103 (a) over
Buckley in view of De Rosa and Puiello

Claim 5 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Buckley in view of De Rosa and Puiello.

Buckley and De Rosa are as stated above. Buckley further discloses Velcro® straps which are secured to each side section (column 5, lines 25-38). De Rosa teaches that the straps may also be Velcro® and be two piece and removable by pulling apart (column 2, lines 50-61). Puiello teaches Velcro fasteners for a reflective harness being passed under a dog or other quadruped's belly (column 4, lines 15-18; see figure 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the two-part Velcro® strips of Puiello and De Rosa for the straps of Buckley in order to ease attachment of the device in the manner illustrated by Puiello and De Rosa.

V. The Rejection of Claim 8 Under 35 U.S.C. §103 (a) over
Buckley in view of De Rosa and Brink and Thielemann

Claim 8 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Buckley in view of De Rosa and Thielemann.

Buckley and De Rosa are as above. Brink teaches that, for a thermal therapeutic wrap, nylon, polyester or other suitable porous material may be used for heat transfer and moisture wicking

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(Column 5, lines 11-12). Thielemann discloses a knitted fabric (column 6, lines 19-20). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to fashion the apparatus out of twill¹ for appearance or to improve heat exchange and wick away moisture by using a porous fabric. Alternatively, we find twill to be a known equivalent to other woven and non-woven fabrics. As stated in In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982) "Express suggestion to substitute one equivalent for another need not be present to render such substitution obvious."

VI. The Rejection of Claims 10 and 11 Under 35 U.S.C. §103(a) over Buckley in view of De Rosa, further in view of Thielemann.

As for claims 10 and 11, Buckley and De Rosa are as above. Thielemann teaches a recessed area 33 (see figure 2) (for claim 10) and a transition area (see area about 33) (for claim 11) extending from the recessed area for the purpose of allowing the animal's neck to raise and lower. Buckley also teaches a strap 27 to retain the appliance in place. It would have been obvious to one of ordinary skill at the time the invention was made to substitute a recessed area and a transitional tapering area for the strap to secure the appliance to the animal being treated.

¹ Twill is a "textile weave in which the filling threads pass over one and under two or more warp threads to give an appearance of diagonal lines" Webster's New Collegiate Dictionary, page 1264.

Summary of Decision

The rejection of Claims 1, 7, 12-14, and 16-18 under 35 U.S.C. § 102(e) as being unpatentable over Thomas is reversed.

The rejection of Claims 3-6, 8-11, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Thomas in view of Brink, further in view of Thielemann is reversed.

Claims 1, 3-4, 6-7, 9, and 12-18 are newly rejected under 35 U.S.C. § 103 (a) over Buckley in view of De Rosa.

Claim 5 is newly rejected under 35 U.S.C. §103 (a) over Buckley in view of De Rosa and Puiello.

Claim 8 is newly rejected under 35 U.S.C. §103 (a) over Buckley in view of De Rosa and Brink and Thielemann.

Claims 10 and 11 are newly rejected under 35 U.S.C. §103(a) over Buckley in view of De Rosa, further in view of Thielemann.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection

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to avoid termination of proceedings (§ 1.197(c)) as to the
rejected claims:

(1) Submit an appropriate amendment of the claims so rejected
or a showing of facts relating to the claims so rejected, or
both, and have the matter reconsidered by the examiner, in
which event the application will be remanded to the examiner.

. . .

(2) Request that the application be reheard under § 1.197(b)
by the Board of Patent Appeals and Interferences upon the
same record. . . .

No time period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED
37 C.F.R. §1.196(b)

CATHERINE TIMM)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
ROMULO H. DELMENDO)	
Administrative Patent Judge)	APPEALS AND
)	
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